

Applicant thanks the Examiner for acknowledging the claim to foreign priority and confirming receipt of the priority document filed on March 25, 2001.

Applicant thanks the Examiner for indicating that the Formal Drawings filed on August 4, 2002 are approved.

## **II. Claim Rejection - 35 U.S.C. § 102**

The Examiner has rejected claims 1-14, 16, 20-21, 24-25, 32, 37-38, 40, 43-51, 53-54, 57, 60-61, 64-65, 67, 72, 74, 76, and 78-86 under 35 U.S.C. § 102 (a & e) as being anticipated by Mayle et al. (US 6,018,774) ["Mayle"]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites an image distributing system for distributing an image having a target character that comprises "an image collecting unit for selecting images ... by identifying the target character according to character information thus obtained for distributing the second image including the target character." (emphasis added). The Examiner contends that the claimed character information is disclosed by Mayle in features such as photo caption (Office Action at page 3) or features such as filtering, color correcting, adding borders, motifs and visual effects (Office Action at page 17).

Applicant submits that the claimed image collecting unit selects the claimed second image from a plurality of images stored as image data "by identifying the target character according to [obtained] character information." As recited, it is clear that the image collecting unit, rather than a user, selects the second image. In one non-limiting example, the image collecting unit sorts through a plurality of images stored in an image database to select an image (claimed second image) with the target character (which may be the user). The benefit of this

feature is that the target character (user) can easily obtain the desired second image without struggling to obtain the picture by him/herself.

In contrast, Mayle merely teaches that a user of a system, which creates messages including image information, must manually (i.e. by hand) select a picture (user-selected photo 603) before distributing the picture. The user must operate the system by him/herself. When selecting a particular picture, the user must manually sort through a large number of pictures which may take a lot of effort by the user.

Applicant submits that the presence of the user does not substitute for the presence of a structural element. The decision in *In re Bell*, 26 USPQ2d 1529 (Fed Cir. 1993) makes clear that method steps such as those performed by a user, do not establish the presence of elemental steps of claims for an apparatus.

Therefore, Mayle fails to teach or suggest the claimed combination and is also silent with respect to the above benefit of the claimed combination.

In addition, Applicant submits that the Examiner's cited examples of character information (even if applicable) are attached to an image in Mayle after the user already selects the image for processing. Therefore, Mayle does not disclose or suggest, even manually, that images are selected "by identifying the target character according to [obtained] character information."

Because method claim 43 and business method claim 78 recite features similar to claim 1, Applicant submits that these claims are patentable for reasons similar to those given above with respect to claim 1.

Applicant submits that claims 2-14, 16, 20-21, 24-25, 32, 37-38, 40, 44-51, 53-54, 57, 60-61, 64-65, 67, 72, 74, 76, and 79-86 are patentable at least by virtue of their respective dependencies.

In addition, Claim 3 recites that “an image selecting terminal showing the images collected by said image collecting unit to a user and prompting the user to select images.” The Examiner contends that user computer 21 corresponds to the claimed selecting terminal. However, the Examiner’s cited sections refer to the creation of a postcard by a user on the terminal, not the claimed showing of images that have been collected.

Claim 4 further defines the image selecting terminal, but the cited section (col. 5, lines 46-52) refers to elements 63 and 64, which are found on the server and not on the user computer (see fig. 2).

Claim 5 recites “means for verifying the user who is to select images based on character information.” The Examiner does not explain how “cookies” (disclosed in the cited section) are related to filtering, color correcting, adding borders, motifs and visual effects (which the Examiner contends are the claimed character information).

Claim 11 recites that “character information includes data about at least one of a facial characteristic, body characteristic, and characteristic of wearing apparel of the target character.” The Examiner cites figures that allegedly have these features, but gives no explanation as to how the invention in Mayle obtains and uses this alleged character information for the claimed selecting images as set forth in claim 1. The Examiner also does not explain why this shift in the definition of character information is consistent with the alleged definition of character information as contended in claim 1.

Claims 85 and 86 recite that the target character is a person shown in the image. The Examiner cites figures that show a person, but again gives no explanation as to how the invention in Mayle selects images with the person (target character) as set forth in claim 1 or how the alleged character information of filtering, color correcting, adding borders, motifs and visual effects are used in selecting the image with the person.

Clearly, the Examiner is just citing sections of Mayle without considering the interrelation between the claimed elements. Therefore, Applicant respectfully submits that the Examiner reevaluate Applicant's claimed combinations with the interrelation in mind.

### **III. Claim Rejections - 35 U.S.C. § 103**

The following is a summary of the rejections under 35 U.S.C. § 103(a):

1. The Examiner has rejected claims 18, 19, 58 and 59 as being unpatentable over Mayle in view of Acosta et al. (US 6,166,729) ["Acosta"].
2. The Examiner has rejected claims 15, 17, 26, 22, 23, 27, 28, 33, 34, 36, 39, 41, 52, 56, 62, 63, 66, 68, 69, 71, 73 and 75 as being unpatentable over Mayle in view of Kuno (US 6, 567,121) ["Kuno"].
3. The Examiner has rejected claims 29-31, 35, 42, 70 and 77 as being unpatentable over Mayle in view of Acosta and further in view of Kuno.

Because these claims are dependent on either claim 1 or claim 43, and because neither Acosta nor Kuno (alone or in combination) cure the deficient teachings of Mayle with respect to claims 1 and 43, Applicant submits that these claims are patentable at least by virtue of their respective dependencies.

Response Under 37 C.F.R. § 1.116  
U.S. Serial No.: 09/864,456

Attorney Docket No.: Q64549

#### IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Pursuant to 37 C.F.R. § 1.136, Applicant is filing a petition (with fee) for one month of extension time herewith, making this response due on or before July 30, 2004. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

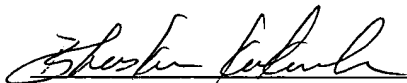
Respectfully submitted,

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER



Bhaskar Kakarla  
Registration No. 54,627

Date: July 26, 2004



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q64549

Toshihiko KAKU

Appln. No.: 09/864,456

Group Art Unit: 2177

Confirmation No.: 1775

Examiner: Srirama T. Channavajjala

Filed: May 25, 2001

For: IMAGE DISTRIBUTING SYSTEM

**RECEIVED**

JUL 29 2004

Technology Center 2100

**STATEMENT OF SUBSTANCE OF INTERVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Please review and enter the following remarks summarizing the interview conducted on  
June 4, 2004:

**REMARKS**

An Examiner's Interview Summary Record (PTO-413) was given to Applicant after the  
interview on June 4, 2004.

During the interview, the following was discussed:

1. Identification of claims discussed: Independent claims 1, 43, 78 and dependent  
claims 3 and 11.
2. Identification of art discussed: Mayle et al. (US 6,018,774)
3. Brief Identification of principal arguments: Applicant argued that Mayle does not  
disclose the claimed image collecting unit.
4. Results of Interview: Agreement was not reached.

STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 09/864,456

Attorney Docket No.: Q64549

**It is believed that no petition or fee is required.** However, if the USPTO deems otherwise, Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

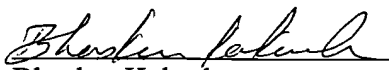
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